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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 12

Application Number: 09/884,490
Filing Date: June 18, 2001
Appellant(s): BROWN ET AL.

Francis Lammes
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/30/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 1-34.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims groups I-VI do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

Cooper et al (Cooper) US 2001/0051996 13 December 2001

(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

[Paper #4]:

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper et al (Cooper), US 2001/0051996, 13 December 2001.

Cooper manages media content with authentication information [0017], which is in turn managed by means of a Certification Authority (CA) [0065], a role that may be taken by virtually any entity.

As to claim 1, the CA receives information from a plurality of users [0066]; stores the information [copyright registry 234], and removes selected information on request [0069].

Alternately, the content itself is provided by a plurality of users, stored in a master database [FIG 2], and upon recognition of piracy, a user may cause the content to no longer be played [0124].

As to claim 2, the digital identification of a user or owner is a "consumer ID", is used to verify any message from a user [0042]. Alternatively, a digital certificate may be checked to see if it is valid or invalid [0124].

As to claims 3-5, a certificate in Cooper determines validity and is clearly personal [0042].

As to claim 6, credit cards are used to charge for services [0078].

As to claim 7, Cooper is intended to be used with the Internet, which typically applies applets within the Java language.

The elements of claims 8-26 are rejected in the analysis above and these claims are rejected on that basis.

[Paper #7]:

Applicant's arguments filed 10/9/03 have been fully considered but they are not persuasive.

Applicant fails to recognize the breadth of the claims.

In the Telephone Interview of 10/7/03 and in the Response, Applicant attempts to draw a distinction between *revoke* and *remove*. Firstly, there is no evidence in the Disclosure that removal of data from memory means anything other than the usual removal of access, which would allow garbage collection processes to reclaim the memory space. Secondly, Webster's New Riverside University Dictionary, Houghton Mifflin Company, ©1984, 1988, defines *revoke* as meaning to nullify by withdrawing, recalling, or reversing. There is no obligation of the revoking authority to re-instate, and thus revocation is equivalent to removal.

Applicant correctly states that patentability depends upon each and every element of a claim, but then argues claims 2-7 in terms of an element of claim 2, whereas claims 3-7 depend directly on claim 1 and do not include that element. (The arguments concerning claims 8-26 are included in this analysis.) New claims 27-34 are addressed below.

As to claim 1, Applicant states [page 11] that Cooper does not teach receiving a request to remove selected information, received from a user in response to a transaction involving the user. To reiterate the rejection, Cooper is directed to transactions in which a user, who obtains a digital certificate which allows access to content selected by the user. [See also 0018; 0060 lines 6-9.] Of course this is done by some management system, but so are the steps of the claims, and a user request is required to trigger the process. As noted at [0065], any entity may act as the certification authority that revokes a user's digital certificate [0069].

Again, such an act cannot be arbitrary, but inherently must be initiated by request, which is itself a transaction in the system.

As to claim 2, [0048] explicitly addresses the revocation of a digital certificate upon failure of attempts to enter a password, which corresponds to removal of information when a request is invalid.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper et al (Cooper), US 2001/0051996, 13 December 2001.

This maintains the rejections of the previous action, which is hereby incorporated in its entirety.

Claims 27-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooper et al (Cooper), US 2001/0051996, 13 December 2001.

These claims are directed to information from a client device or stored on a server. As noted in the previous action at [0058; 0065], and elsewhere, Cooper is quite general with respect to platforms, and includes the options of receiving from clients and storing on servers.

(11) *Response to Argument*

It is agreed that Cooper teaches the **removal of access** to information but not a permanent removal by **erasure**. However, the claims also do not specify erasure, they claim an unspecified form of removal of which the removal of access is one form.

It is not clear that the Specification supports permanent removal in light of the use in the art of **stronger** terms such as *delete*, *undelete*, *install* and *uninstall*, all of which are closely related to removal or restoration of **access**, rather than to erasure or write-over. Evidence of this position of the state of the art at the time of the invention is provided by Davis, US 6,615,224, of September 2003 and Bernhard et al, US 6,275,942, 14 August 2001.

In more detail, the crux of the issue in this appeal is whether there is a distinction between remove in the sense of **revoking access** [Cooper] and the **remove** of the claims. The Specification illustrates *remove* in ways that could imply erasure, but is not so specific. It is noted that in the art even the stronger term *delete* (as for files) may only imply removal from a directory, which can then be reversed with an *undelete*, restoring the file access to the directory. Clearly, there is no erasure from storage at that point.

Nowhere in the Specification do the following combinations occur:

- a. eras[e/ure]
- b. permanent in the same sentence as remov[e/al]
- c. persistent in the same sentence as remov[e/al]

It is considered that these combinations are so well known in the art that no such support is required under 112 first paragraph in order for them or their equivalents to be included in the claims. Applicant has chosen not to do this, and consequently it follows that the claims are intended to have a larger scope, which includes removal of access.

As to the use of the term "server" in the arguments, essentially everything in Cooper is located on a server of some sort.

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Applicant argues the Specification, not the claims. Using claim 1 as exemplary, Applicant refers to "stored information of a user" at Brief, page 8 (2/3 down), which does not appear in the claim. Again on page 10 second paragraph, Applicant refers to "removing information about a user", which is not in the claim.

With regard to claims 8-13, 21-23 and 25-26 [Brief page 10], Applicant refers to a Web page not being explicitly rejected. **Applicant is responsible for the four corners of the reference.** Cooper clearly anticipates the use of Web pages, as seen in FIG 6-7 and [0006].

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

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May 19, 2004

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